

REMARKS

Claims 1, 4-23, 25, and 26 are pending in the present application. In the Office Action mailed February 23, 2010, the Examiner rejected claims 8, 12-14, 16, and 17 under 35 U.S.C. §112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which Applicant regards as the invention. The Examiner next rejected claims 1, 4-7, 10, 15, 23, 25, and 26 under 35 U.S.C. §103(a) as being unpatentable over Manduley (USP 5,956,505) in view of Tajima et al. (USP 6,402,737). Claims 8, 9, 11-14, 16, 17, and 18-22 were rejected under 35 U.S.C. §103(a) as being unpatentable over Manduley in view of Tajima et al., further in view of Official Notice.

Rejections under 35 U.S.C. §112, second paragraph

The Examiner rejected claims 8, 12-14, 16, and 17 under 35 U.S.C. §112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which Applicant regards as the invention. Responsive thereto, Applicant has amended each of claims 8, 12-14, 16, and 17 to further clarify what is being called for therein.

In light of the amendments, Applicant believes that the rejections under 35 U.S.C. §112, second paragraph, are rendered moot and therefore respectfully requests withdrawal thereof.

Rejections under 35 U.S.C. §103(a) over Manduley in view of Tajima et al.**Claims 1 and 23**

The Examiner rejected claims 1 and 23 under 35 U.S.C. §103(a) as being unpatentable over Manduley in view of Tajima et al. In rejecting the claim, the Examiner asserted that “[i]t would have been obvious to... include in Manduley the user authentication system as taught by Tajima, since the claimed invention is merely a combination of old elements, and in the combination, each element merely would have performed the same function as it did separately.” *Office Action*, February 23, 2010, p. 5. Applicant respectfully disagrees with the rejection. Specifically, Applicant believes that the combination of references fails to teach or suggest that which is called for in each of claims 1 and 23.

Each of claims 1 and 23 call for, in part, a method to remotely enable software-enabled options in a device that includes the steps of receiving a user I.D. at a centralized facility, receiving an option-enabling request specifying an option requested to be enabled in equipment/device at a subscribing station, confirming that the option has not already been enabled, generating an enabling feature at the centralized facility upon confirmation that the

option has not already been enabled, the enabling feature comprising a software key designed to enable software already installed in the equipment, sending the enabling feature from the centralized facility to the equipment/device in the subscribing station, and activating the option in the equipment/device.

In rejecting claims 1 and 23, the Examiner admitted that “Manduley does not explicitly disclose: receiving a user ID at a centralized facility from a user,” and thus relied on Tajima for teaching “receiving a user ID (figure 6, reference 601) at a centralized facility (figure 1, reference 127) from a user (figure 1, reference 114).” *Office Action*, supra at 4-5. Tajima, however, fails to teach or suggest receiving a user ID at a centralized facility. Instead, Tajima discloses a surgical apparatus with means provided for automatically and dynamically changing the operation of respective elements thereof. *Tajima*, Abstract. The surgical apparatus includes a plurality of devices, a supervisory controller 126 for generally controlling the devices, a user authenticating means 127 including an input device of an IC (Integrated Circuit) card reader or the like, and a transmission path 128 among the plurality of devices. *Tajima*, Col. 4, Ins. 51-60. The plurality of devices of the surgical apparatus can include, for example, a diseased tissue manipulating means 102 such as a scalpel, optical fiber laser, a pipe for injecting physiological salt water and so on; a work environment data detecting means 104 such as a force sensor, a proximity sensor, a visual sensor; and an *in vivo* data measuring means 117 such as an MRI or CT scanner. *Tajima*, Col. 4, Ins. 14-28. The supervisory controller 126 carries out setting and control of each device of the surgical apparatus, such as by way of input from a user into user authenticating means 127 indicating a desired usage of the device. The user authenticating means may receive input via one of a keyboard, a mouse, an IC card reader, a fingerprint reading device, a voice pattern analyzing device, or a retina pattern photographing device. *Tajima*, Col. 8, Ins. 1-4. An input into authenticating means 127 can be transmitted to supervisory controller 126 within the surgical apparatus by way of transmission path 128, which can be a bus prescription of a computer or the like. See *Tajima*, Cols. 5 and 6.

There is no teaching or suggestion in Tajima, however, of receiving a user I.D. at a centralized facility. That is, the user authentication for use of the surgical apparatus in Tajima is provided by an authenticating means 127 integrated into the surgical apparatus. As set forth above, input from a user into the authenticating means 127 is transmitted within the surgical apparatus to supervisory controller 126 by way of a computer bus 128. Input from a user into the authenticating means 127 is thus received at the surgical apparatus, processed in the surgical apparatus, and authenticated in the surgical apparatus so as to allow for user operation of a device

of the surgical apparatus. There is simply no teaching or suggestion provided in Tajima of receiving a user I.D. at a centralized facility that is separate/remote from the surgical apparatus itself (i.e., a centralized facility that is separate from equipment/device at a subscribing station), as is called for in claims 1 and 23.

For at least the reasons set forth above, the combination of Manduley and Tajima et al. fails to teach or suggest a method to remotely enable software-enabled options in a device that includes the steps of receiving a user I.D. at a centralized facility, receiving an option-enabling request specifying an option requested to be enabled in equipment/device at a subscribing station, confirming that the option has not already been enabled, generating an enabling feature at the centralized facility upon confirmation that the option has not already been enabled, the enabling feature comprising a software key designed to enable software already installed in the equipment, sending the enabling feature from the centralized facility to the equipment/device in the subscribing station, and activating the option in the equipment/device. Claims 1 and 23, and the claims dependent therefrom, are thus patentably distinct from the cited references.

Claim 10

The Examiner also rejected claim 10 under 35 U.S.C. §103(a) as being unpatentable over Manduley in view of Tajima et al. Applicant respectfully disagrees with the rejection.

Claim 10 calls for, in part, a option-enabling system including a subscribing station having at least one in-field product and at least one computer programmed to control the in-field product, an on-line center capable of receiving and authenticating a user I.D., validating an option request, and creating an option key in response thereto, and a communications network to relay data from the on-line center to the subscribing station to transmit the option key from the on-line center to the subscribing station in response to a user I.D. receipt and authorization, and a valid option request receipt.

As set forth above with respect to claims 1 and 23, the combination of Manduley and Tajima et al. fails to teach or suggest an on-line center capable of receiving and authenticating a user I.D. and creating an option key in response thereto. Tajima et al. merely teaches a surgical apparatus having a supervisory controller 126 and a user authenticating means 127, with the supervisory controller 126 carrying out setting and control of devices of the surgical apparatus based on input from a user into user authenticating means 127. However, there is not teaching or suggestion in Tajima et al. (alone or in combination with Manduley) of an on-line center capable of receiving and authenticating a user I.D. That is, the user authentication for use of the surgical apparatus in Tajima is provided by an authenticating means 127 integrated into the surgical

apparatus. As set forth above, input from a user into the authenticating means 127 is transmitted within the surgical apparatus to supervisory controller 126 by way of a internal computer bus 128. Input from a user into the authenticating means 127 is thus received at the surgical apparatus, processed in the surgical apparatus, and authenticated in the surgical apparatus so as to allow for user operation of a device of the surgical apparatus. There is simply no teaching or suggestion provided in Tajima of an on-line center that is separate from the surgical apparatus and that is capable of receiving and authenticating a user I.D., as is called for in claim 10.

For at least this reason, claim 10 and the claims dependent therefrom are patentably distinct from the combination of Manduley and Tajima et al.

Rejections under 35 U.S.C. §103(a) over Manduley in view of Tajima et al., further in view of Official Notice

Claim 18

The Examiner rejected claim 18 under 35 U.S.C. §103(a) as being unpatentable over Manduley in view of Tajima et al., further in view of Official Notice. Applicant respectfully disagrees with the rejection and believes that the combination of cited references fails to teach or suggest what is called for in claim 18.

Initially, Applicant would point out that, in rejecting claim 18, the Examiner did not specifically address several of the elements specifically called for in the claim. For example, the Examiner failed to address the element(s) in claim 18 setting forth the steps of comparing the option-enabling request with any other option requests for that system I.D. in the database at the on-line center and rejecting the option-enabling request if the comparison results in a predefined number of matches, otherwise, generate an option key and forward the option key to one of the user and the medical device to enable the option. Nowhere in the present rejection has the Examiner set forth where in either of Manduley and Tajima et al. a step of comparing the option-enabling request with any other option requests for that system I.D. in the database at the on-line center for rejecting the option-enabling request if the comparison results in a predefined number of matches. The Examiner has completely omitted these elements in his examination of the claim. Therefore, on its face, the rejection of claim 18 is improper.

Furthermore, in rejecting claim 18, the Examiner relied in part on Official Notice, stating that “[t]he Examiner takes Official Notice that receiving and validating a system ID, as well as generating a key specific to a system ID, were old and well-known in the art because they create[]

a more secure system, whereby only authorized units are able to utilize specific software.” *Office Action*, supra at 7.

Applicant believes that the Examiner’s application of Official Notice is inappropriate under the Manual Patent Examining Procedure (MPEP). “The Examiner may take Official Notice of facts outside of the record which are capable of instant and unquestionable demonstration as being ‘well-known’ in the art.” MPEP §2144.03. However, MPEP §2144.03 is clear that “such rejections [relying on official notice] should be judiciously applied,” be “rare,” and be used “[i]n limited circumstances.” Furthermore, “any facts so noticed should be of notorious character and serve only to ‘fill in the gaps’ in an insubstantial manner which might exist in the evidentiary showing made by the Examiner to support a particular ground for rejection.” MPEP §2144.03. Applicant does not believe that the Examiner’s use of Official Notice is merely to “fill in the gaps.” That is, the Examiner took Official Notice of an entire element of the claim (“receive a system I.D. and validate the system I.D. with data from a database at the on-line center”), thereby effectively attempting to fill-in apparent “holes” in the rejection rather than “gaps.” The use of Official Notice is hereby traversed. The Examiner must “cite a reference in support of his or her position” should the Applicant traverse the assertion. MPEP §2144.03.

For at least the reasons set forth above, Applicant believes that claim 18 and the claims dependent therefrom are patentably distinct from the combination of Manduley and Tajima et al. Applicant thus respectfully requests withdrawal of the rejection.

Claims 8, 9, 11-14, 16-17, and 19

For each of claims 8, 9, 11-14, 16-17, and 19, the relied in part on Official Notice in rejecting the claims, asserting in each instance that the elements specifically called for in the respective claims are “old and well-known.” See *Office Action*, supra at 7-10. As set forth above with respect to claim 18, Applicant believes that the Examiner’s application of Official Notice is inappropriate under the Manual Patent Examining Procedure (MPEP). As set forth in MPEP §2144.03 rejections relying on official notice “should be judiciously applied” and be used “[i]n limited circumstances.” Furthermore, “any facts so noticed should be of notorious character and serve only to ‘fill in the gaps’ in an insubstantial manner which might exist in the evidentiary showing made by the Examiner to support a particular ground for rejection.” MPEP §2144.03. Applicant does not believe that the Examiner’s use of Official Notice is merely to “fill in the gaps,” as the Examiner has taken Official Notice of eight (8) separate claims, thus evincing that the Official Notice taken by the Examiner has not been applied “judiciously.” The use of Official

Notice is hereby traversed. The Examiner must “cite a reference in support of his or her position” should the Applicant traverse the assertion. *MPEP §2144.03*.

Therefore, in light of at least the foregoing, Applicant respectfully believes that the present application is in condition for allowance. As a result, Applicant respectfully requests timely issuance of a Notice of Allowance for claims 1, 4-23, 25, and 26.

Applicant appreciates the Examiner’s consideration of these Amendments and Remarks and cordially invites the Examiner to call the undersigned, should the Examiner consider any matters unresolved.

Respectfully submitted,

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General Authorization and Extension of Time

The Commissioner is hereby authorized to charge any additional fees which may be required regarding this application under 37 C.F.R. §§ 1.16-1.17, or credit any overpayment, to Deposit Account No. 50-2402. Should no proper payment be enclosed herewith, as by credit card authorization being in the wrong amount, unsigned, post-dated, otherwise improper or informal or even entirely missing, the Commissioner is authorized to charge the unpaid amount to Deposit Account No. 50-2402. If any extensions of time are needed for timely acceptance of papers submitted herewith, Applicant hereby petitions for such extensions under 37 C.F.R. §1.136 and authorizes payment of any such extensions fees to Deposit Account No. 50-2402. Please consider this a general authorization to charge any fee that is due in this case, if not otherwise timely paid, to Deposit Account No. 50-2402.

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